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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,938	02/07/2002	Robert John Mulligan	CM01562L	9852

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MOTOROLA INC  
600 NORTH US HIGHWAY 45  
ROOM AS437  
LIBERTYVILLE, IL 60048-5343

EXAMINER

NGUYEN, QUYNH H

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/071,938		MULLIGAN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Quynh H. Nguyen		2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on remarks filed 7/7/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-34 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-34 and 40-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 07/07/06 has been entered. Claims 26, 28-29, 31-34, and 40-48 have been amended. No claims have been cancelled. No claims have been added. Claims 26-34 and 40-50 are still pending in this application, with claims 26, 29, 32, 34, and 40 being independent.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one of non-thermal, non-visual sensation feature(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **CLAIMS**

#### **112 First Paragraph Rejection**

4. Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See comments below.

Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant merely uses haptic producing substance without any specifics, i.e. what the substance is? And sensory producing

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substance, i.e. non-thermal, non-visual. There are very few places with a few lines in Applicant's specification - page 6, lines 6-13 and page 11, lines 3-7 - that merely discussed about haptic and sensory producing substance (non-thermal, non-visual); and the rest of the specification is directed to color changing substance, pattern changing substance, illumination producing substance, and shape changing substance. Furthermore, there is no drawing to support non-thermal, non-visual sensation feature(s). Thus, evidencing Applicant does not have possession of the invention.

In all independent claims 26, 29, 32, 34, and 40 that recite "at least one non-thermal, non-visual sensation", the 112 first paragraph rejection is maintained for the case "at least one non-visual sensation".

In claims 26, 29, 32, 34 and 40, they all recited "non-visual sensation". This is questionable and contradicting the original disclosure which stated that it has "visual" effects in pages 2, 13-15 of the original disclosure. Therefore, it is considered as unenabling and possibly a new matter.

### **Art Rejection**

5. Claims 26-34 and 40-50, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lehtiniemi et al. (US 6466299).

Regarding claim 26, Lehtiniemi teaches a housing (fig. 1) comprising:

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an outer surface (C) which includes a sensory producing substance (A1-A4) producing at one non-thermal, "*non-visual*" (see also 112 rejection above) sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 29, Lehtiniemi teaches a housing (fig. 1) comprising:

an outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at one non-thermal, "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 32, Lehtiniemi teaches a housing (fig. 1) comprising:

an outer surface (C) including at least one shape element (see A1-A4) that includes a sensory producing substance (A1-A4) that produces at one non-thermal, "*non-visual*" sensation responsive to at least one stimulus generated by a plurality of internal components (col. 1, lines 58-67).

Regarding claim 34, Lehtiniemi teaches a housing (fig. 1) comprising:

an outer surface (C) which includes a sensory producing substance (A1-A4) that produces at least one adjustably, non-thermal, "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claim 40, Lehtiniemi teaches a housing (fig. 1) comprising:

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an outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at least one non-thermal, "*non-visual*" sensation responsive to one or more operation of a plurality of internal components (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claims 27-28, 30-31, 33 and 41-50, Lehtiniemi teaches:

the housing (fig. 1);

the sensory producing substance is a combination of one or more substances selected from a group comprising a thermal producing substance, a vibration producing substance, and a haptic producing substance (col. 1, lines 58-67);

the sensory producing substance causes the housing to provide to a user one or more sensations selected from a group comprising heat, pressure, and texture (col. 1, lines 58-67, col. 2, lines 3-14);

the stimulus is a combination of one or more stimuli selected from a group consisting of an acoustic, a thermal, an electrical, an electromagnetic, an olfactory, and a mechanical stimulus (col. 1, lines 58-67);

the one or more operations is selected from a group comprising a light from a keypad, light from a display, a vibration from an alerting mechanism, an audible alert from a speaker (col. 1, lines 66-67, col. 4, lines 39-46, col. 8, lines 16-19).

### **ARGUMENT**

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6. In response to the remarks filed on 07/07/06, arguments by Attorney can not take place of evidence. Applicant mainly argues about "non-visual" sensation. This issue has been addressed above in the 112 rejection, see comments above. Since the 112 rejection maintained, the art rejection is also maintained.

7. Applicant's arguments with respect to claims 26-34 and 40-50 have been fully considered but are not persuasive.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

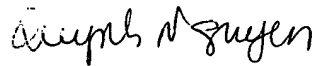
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Mon.-Thu. from 6:30A.M. to 5:00P.M.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quynh H. Nguyen  
Primary Examiner  
Art Unit 2614